

REMARKS

By this amendment, Claims 5-9 have been amended to address the Board's concern regarding the preamble, and whether it serves as a limitation. In the amended claims the requirement for promotion of whole body health is in the body of the claim. In addition, new Claims 10-12 are added, which are supported by the specification and claims as originally filed (see, in particular, original Claims 5, 6, and 8 and p. 29, *l.* 32 - p. 32, *l.* 8 and p. 15, *ll.* 3-8).

Applicants believe the present claims are novel in light of the prior art for the following reasons. First, Applicants submit that the methods recited in Claims 5 - 9 are not anticipated by U.S. Patent No. 5,364,616 by Singer (hereinafter "Singer"). The claimed invention is the exact opposite of the teachings of Singer. The method disclosed in Singer *requires an H2-antagonist* and optionally an antimicrobial agent. In contrast, the instant claims *require an antimicrobial agent* and optionally can include an H2-antagonist. In this regard, new Claims 10-12 are clearly novel over Singer because the methods recited therein specifically exclude the use of H-2 antagonists - - the therapeutic agents specifically required by Singer.

Secondly, there is no evidence in the record to support the Examiner's and the Board's finding that practicing the method of Singer inherently anticipates the claimed invention of Claims 5 - 9. A finding of inherency requires that practicing the prior art method would necessarily and inevitably result in the claimed invention, *i.e.*, promotion of whole body health. Inherent anticipation must be established by more than mere probabilities or possibilities. In order for a prior art reference to amount to an inherent anticipation of a claim, all the elements of the claim must *necessarily, inevitably* and *always* result from the prior art disclosure; mere possibilities or probabilities are not sufficient. *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981), citing *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939). "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Rapoport v. Dement* 254 F.3d 1053, 1063 (Fed Cir. 2001), citing *Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir.1991) (emphasis in original). Furthermore, an accidental or unwitting duplication of an invention may not constitute an anticipation. *In re Marshall*, 578 F.2d 301, 304 (Fed Cir. 1978). Thus, in order for Singer to inherently anticipate the claimed invention, the method described in Singer must result in the claimed invention, *i.e.*, promotion of whole body health, *each time and every time* Singer's method is

practiced. Given the vagaries of how the Singer method may be practiced, inherent anticipation of the claimed method has not been established in this record.

In light of the amendments and remarks above, Applicants estimate that the pending claims are allowable. Applicants respectfully request that the foregoing amendments and remarks in be made of record in the instant application.

Respectfully submitted,

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